

REMARKS/ARGUMENTS

The Pending Claims

Claims 1, 3, 4, 10, 12, 14, 15, 20, 21, 28, 31-34, 36, and 37 are pending.

Summary of the Claim Amendments

Claims 2, 6, 8, 9, 11, 26, 27, and 29 have been canceled as directed to non-elected subject matter. Claims 1 and 10 have been amended to delete non-elected subject matter. In view of the amendment to claim 1, claims 5 and 7 have been canceled as superfluous.

Claims 1, 3, 4, 10, 12, 14, 15, 20, 21, 28, and 31-34 have been amended replace the term “an ester” with “a carboxylate ester,” as supported by the specification at, for example, page 10, lines 8-14 and the Examples.

Claim 12 has been amended to recite a pharmaceutical composition. Claims 14, 15, 31, and 32, which recite a pharmaceutical composition, have been amended to place them in proper format for a pharmaceutical composition. Claims 21 and 34 have been amended to delete the phrase “preventing or.” Claims 20 and 33 have been amended to recite a method of treating diabetic nephropathy. These amendments are supported by the specification at, for example, page 3, lines 8-15.

The dependencies of claims 12, 14, 15, 20, 21, and 31-34 also have been amended. Claims 13, 30, and 35 have been canceled.

New claims 36 and 37 are the same as amended claims 33 and 34, except that new claims 36 and 37 depend on claim 10 (rather than claim 3).

No new matter has been added by way of these amendments.

Claim for Priority

Applicants note that the Office Action acknowledges receipt of only “some” of the certified foreign priority documents. Applicants note that there is only one foreign priority document, which was submitted to the International Bureau upon the filing of International Patent Application No. PCT/JP04/14684. Therefore, Applicants understand that the Office’s

receipt acknowledgement is for the single priority document, and no further action in this regard needs to be taken. If, however, Applicants' understanding in this respect is incorrect, then the Examiner is advised to so inform Applicants.

Summary of the Office Action

The claims pertinent to the subject matter of elected Group VIII have been clarified, and claims 12-15, 20, 21, and 30-34 have been rejoined with elected Group VIII.

Claims 1, 3-5, 7, 10, 12-15, 20, 21, 28, and 30-34 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claims 12-15, 20, 21, and 30-34 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement.

Discussion of the Restriction Requirement

In response to the request of Applicants, the Examiner has clarified the claims pertinent to elected Group VIII, namely, claim 7 in full and claims 1, 3-5, 10, 12-15, 20, 21, 28, and 30-34 in part) and has rejoined claims 12-15, 20, 21, and 30-34, which are drawn to pharmaceutical compositions and methods of using the compounds of elected Group VIII. Nonelected claims 2, 6, 8, 9, 11, 26, 27, and 29, which are directed to non-elected subject matter and which are not subject to rejoinder, have been canceled. In addition, as indicated above, non-elected subject matter has been deleted from the remaining claims.

Discussion of the Indefiniteness Rejections

Claims 1, 3-5, 7, 10, 12-15, 20, 21, 28, and 30-34 allegedly are indefinite. The Examiner contends that the use of the term "ester" is confusing because the type of ester is not specified. Claims 1, 3, 4, 10, 12, 14, 15, 20, 21, 28, and 31-34 have been amended replace the term "an ester" with "a carboxylate ester," as supported by the specification. The pending claims, therefore, are now directed to a specific type of ester.

In addition, the term "medicament" in claim 12 allegedly is confusing. Claim 12 has been rewritten as a composition claim.

In view of these amendments, the indefiniteness rejections have been overcome.

Discussion of the Enablement Rejections

Claims 12-15, 20, 21, and 30-34 allegedly lack enablement. The Examiner contends that, while these claims potentially are enabled for treating specific diseases, the specification does not reasonably provide enablement for preventing diseases. As indicated above, claims 13 and 30 have been canceled. Claims 12, 14, 15, 31, and 32, have been amended to recite pharmaceutical compositions. To advance prosecution and not in acquiescence of the rejection, claims 21 and 34 have been amended to delete the term "preventing."

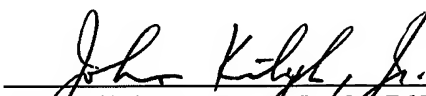
The Examiner also contends that claims 12-15, 20, 21, and 30-34 are not enabled for inhibiting the formation of advanced glycation end products (AGEs) and therefore are not enabled to treat unspecified diseases associated with the formation of AGEs. Applicants believe that this rejection applies only to claims 20 and 33 inasmuch as the other pending claims do not reference inhibiting the formation of AGEs. To advance prosecution and not in acquiescence of the rejection, claims 20 and 33 have been amended to recite a method of treating diabetic nephropathy. Diabetic nephropathy is a condition associated with the formation of AGEs.

In view of these amendments, the enablement rejections have been overcome.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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